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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,833	01/30/2002	Takashi Murata	MURATA ET AL-I	5693

7590 04/20/2004

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1077 Northern Boulevard
Roslyn, NY 11576

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,833

Applicant(s)

MURATA ET AL.

Examiner

Elizabeth A. Bolden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-16 is/are rejected.
- 7) ☒ Claim(s) 1,10 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an applications filed in Japan on 1 February 2001 and 17 May 2001. It is noted, however, that applicant has not filed a certified copy of the JP 2001-26116 and 2001-147782 applications as required by 35 U.S.C. 119(b).

Claim Objections

Claims 1, 10, and 14 are objected to because of the following informalities:

Regarding claims 1, 10, and 14, the phrase "plate-like " is objected to because it is unclear whether the limitations following the phrase are part of the claimed invention.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 2 recites the limitation "the ratio" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa, U.S.

Patent 5,851,939.

Miwa teaches an alkali free glass substrate having overlapping ranges of components with instant claims 1, 2, 7, 9, 10, and 13-15. See abstract of Miwa and column 4, lines 29-31. Miwa teaches overlapping ranges of density, erosion resistance and thermal strain (instant claims 1, 4, 5, 10, and 14 recitations). See column 1, lines 55-64, column 2, lines 46-50, and column 6 line 65 to column 7, line 11. Miwa teaches that the glass substrate is used for display technologies including LCD, EL displays, and polycrystalline silicon TFT. See column 1, lines 11-14 and 60-61.

Miwa fails to teach any anticipatory examples or compositional ranges and properties ranges sufficiently specific to anticipate the instant invention. However, Miwa teaches ranges of components and properties, which overlap the instant claims. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

The reference fails to teach the thermal expansion, liquidus temperature, and specific modulus properties of instant claims 1, 3, 6, 10, and 14, however, one of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same thermal

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expansion, liquidus temperature, and specific modulus properties as recited in claims 1, 3, 6, 10, and 14.

As to claim 8, the recitation that the glass is formed by the “down-draw process” is a process recitation in a product claim. Product claims including process recitations are not limited by the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present instant, the process steps imply that the glass is in the form of a plate. The reference teaches such a product. See column 4, lines 60-61.

Response to Arguments

Applicant's arguments see pages 7-11, filed 9 February 2004, with respect to the rejection of claims 1-16 over Kohli and Lautenschlager et al. have been fully considered and are persuasive. The rejection of claims 1-16 over Kohli and Lautenschlager et al. has been withdrawn. In view of the Declaration filed 9 February 2004, the Applicants' have shown that the glass of the instant invention has improved hydrochloric acid resistance and buffered hydrofluoric acid resistance over the prior art of Kohli and Lautenschlager et al.

Applicant's filed a terminal disclaimer over the 103(a) rejection in view of US 5,851,939. The filing of a terminal disclaimer does not overcome the art rejection of a 103(a), further more the US 5,851,939 patent has an applicable date of a 102(b). A terminal disclaimer only overcomes a double patenting rejection, which was not made in this application.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 571-272-1363. The examiner can normally be reached on 9:30 am-7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EAB
17 April 2004


KARL GROUP
PRIMARY EXAMINER
GROUP 1755